

### **REMARKS**

The present amendment is in response to the Office Action dated April 6, 2005, where the Examiner rejects claims 27-44, and in response to the Office Action dated November 30, 2005 in which the Examiner withdraws all pending claims 35-38 and 40-49.

In response Applicant cancels all claims 1-49 and adds new claims 50-63. Reconsideration and allowance of the pending claims in view of the amendments and the following remarks are respectfully requested.

#### **A Response to withdrawal of claims in the November 30, 2005 Office Action.**

In response to the Examiner's withdrawal of all of the pending claims 35-38 and 40-49, Applicant cancels all pending claims and adds corresponding new claims 50-63 in order to "supply the omission or correction" as allowed per paragraph 2 of the November 30, 2005 Office Action. The new claims correspond to the prior pending claims except that the claim language cited by the Examiner as independent or distinct from the originally claimed invention has been removed from the new independent claims 50 and 57.

Specifically, the Examiner recites the offending limitation of independent claim 35 as "...device for initiating a log in request". This language is eliminated in the corresponding new independent claim 50. Similarly, the Examiner recites the offending limitation of independent claim 43 as "...device sending a request to log into the instant...". This language is eliminated in the corresponding new independent claim 57.

As discussed below, Applicant asserts that the claim inventions of independent claims 50 and 57 are patentable based upon the proxy server limitations.

#### **B. Informalities of Specification, April 6, 2005 Office Action Paragraph 6.**

a. Regarding the amended paragraph, the Applicant's representative reviewed the US publication US20020165000 of the original specification (paragraph [30]) to verify the correct "original" status of the paragraph. (Applicant refers to this publication for clarity.) Only one typographical error exists in the fourth sentence of the paragraph

as follows:

"For example, if the wireless communication device 100 is a wireless telephone, then in block ~~200~~ 302 the telephone is turned on but no voice or data connection is made with the wireless communications network 200"

In the first response to the first office action, Applicant attempted to correct this typo, and Applicant assumes that the amendment was entered. Unfortunately, in the amendment, Applicant's representative introduced another typo, and the Examiner then required correction of this typo, that is, "d3evice" to --device--. In a response to a subsequent office action, Applicant's representative attempted to correct this typographical error, and added yet another typographical error, which the present Examiner has noted and did not enter. Applicant's representative is afraid she might add yet another typographical error if she tries to do anything to the paragraph. Thus, unless the Examiner requires otherwise, Applicant believes that no further amendment is required on this paragraph.

b. The Examiner required "of" to be added to Claim 42. Canceled claim 42 corresponds to claim 56 which includes "of" as required by the Examiner.

**C. Rejection under 35 U.S.C. §112 of claims 27, 34, 35, 37, 38, 44 of the April 6, 2005 Office Action**

Applicant has reviewed all claims as requested by Examiner to ensure that the claims contain subject matter which is described in the specification. In response, new claims 50, 52, 53 and 58 (corresponding to canceled claims 35, 37, 38 and 44) are written to comply with the written description requirement. Specifically, the claims are amended to agree with the description of paragraphs [0030] - [0036], as numbered in the US publication for this application, wherein it is described that the proxy server (not the SMS center as previously claimed) converts the IM messages to SMS formatted messages, and wherein the proxy server establishes presence information and determines active status of the wireless communication device, etc. Applicant asserts that these amendments put the claims in a state for allowance as the cited prior art does not teach or suggest a proxy server as discussed below.

**D. Rejection under 35 U.S.C. §102(e) of the April 6, 2005 Office Action**

The Examiner rejects independent claims 35 and dependent claims 36-42 under 35 U.S.C. 102(e) as being anticipated by the Carey Patent No. 6,714,793 (hereinafter the Carey patent). Claim 43 is rejected as being anticipated by the Mendiola Publication US2002/0143916, hereinafter the Mendiola publication. In response, new independent claims 50 and 57 (corresponding to claims 35 and 43) claim an embodiment of Applicant's invention in which the proxy server intercepts and stores messages intended for a wireless communications device. The proxy server then processes the message as claimed in the dependent claims.

Applicant discloses the use of a "proxy server" which stands in for, or substitutes, for the wireless communication device on an Instant Messaging (IM) network. (See for example "proxy" as defined by Webster's Ninth New Collegiate Dictionary, Merriam-Webster, Inc. 1987). Referring to the cited prior art, Carey's "instant message routing server" 24, as shown in Figure 1, acts as a converter and conduit, only, between an IM and an SMS network. Referring to the flow chart of Figures 6 and 7 of Carey, if the recipient is the instant message routing server, block 144, the instant message routing server prepares the entire instant message and sends it to the short message service center, block 150. The mobile unit, through the carrier, either receives or does not receive the message, block 162. If the message is not received, the mobile carrier sends a message to the instant message routing server, block 174. The instant message routing server then logs off the instant message server, block 176. If the mobile unit receives the message, then the short message service center deletes the stored message, block 166. Thus, Carey's routing server does not store or make decisions about how to handle messages beyond simply converting and routing the messages. The Mendiola publication also does not disclose the use of a proxy server. As shown in Figure 1 of Mendiola, a SMSC 106 is connected to an internet 113, and the internet 113 is connected to an instant message server system 13. A proxy server is neither taught nor suggested by Mendiola.

In contrast, as disclosed by Applicant in paragraphs [0036] - [0039] and Figure 3 of the publication, the proxy server may save the entire instant message for the user

and decide whether to notify the user of the message, send a part of the message, send an identifier of the message, etc. Therefore, the proxy server disclosed and claimed by Applicant servers as a proxy for the wireless communications device, that is, the proxy server is more than just a routing server as disclosed by Carey. As such, Applicant asserts that the claims are patentable over the prior art as further discussed below. Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims.

1. Independent claim 50, and dependent claims 51-56

Independent apparatus claim 50 (corresponding to canceled claim 35) is not anticipated in view of the Carey patent (US 6714793) since the Carey patent fails to teach or suggest each and every element of independent claim 50. Specifically, claim 50 comprises, among other things,

"a proxy server having a first connection to the SMS center and a second connection to the data network, the proxy server for establishing a substitute proxy presence on the data network for the wireless communications device, the proxy server for transmitting presence information to the instant messaging service to indicate that the wireless communications device is online as long as the wireless communications device is in the active state, the proxy server for intercepting and storing an instant message addressed to the wireless communications device"

The Carey patent does not teach or suggest a proxy server that intercepts and stores an instant message intended for a wireless communications device as claimed in claim 50 by Applicant. Thus, claim 50 is patentable over the prior art. Further, the other cited prior art including the Mendiola publication and the Gudjonsson and the Polychronidis patents fail to cure the basic deficiencies of the Carey patent. The dependent claims add further limitations on the patentable base claim. As such, Applicant respectfully requests that the Examiner issue a notice of allowance for independent claim 50 and the claims dependent thereupon.

**2. Independent claim 57, and dependent claim 58-63**

Independent method claim 57 (corresponding to canceled claim 43) is not anticipated in view of the Mendiola publication since the Mendiola fails to teach or suggest each and every element of independent claim 57. Specifically, claim 57 comprises the steps of, among other things,

" the proxy server establishing a stand-in on-line presence for the wireless communications device with the instant messaging service;

the proxy server maintaining the stand-in on-line presence as long as the wireless communications device remains in the active message state status; and

the proxy server intercepting and storing at least one instant message intended for the wireless communications device."

Mendiola does not disclose the use of a proxy server as discussed above. Further, the other cited prior art including the Carey, the Gudjonsson and the Polychronidis patents fail to cure the basic deficiencies of Mendiola. The dependent claims add further limitations on the patentable base claim. As such, Applicant respectfully requests that the Examiner issue a notice of allowance for independent method claim 57 and the claims dependent thereupon.

**E. Rejection under 35 U.S.C. §103(a) of the April 6, 2005 Office Action**

The Examiner rejects method claims 27-34 as being unpatentable over Gudjonsson in view of Polychronidis, and claim 44 is rejected as being unpatentable over Mendiola in view of Carey. Claim set 27-34 is canceled. Canceled claim 44 corresponds to now pending claim 58, which is dependent upon claim 57. As discussed in section C(2) of this response, the cited prior art does not teach or suggest the invention as claimed in independent claim 57. Specifically, the cited art does not teach a proxy server with intercepts and stores an instant message intended for a wireless communications device. Thus, Applicant asserts that independent claim 58, which is dependent on a patentable base claim, is also patentable over the cited art.

**F. Conclusion**

Applicant asserts that the pending claims are now patentable over the cited prior art, and Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims 50-63.

Applicant requests that the Examiner telephone the attorney for Applicant at the telephone number listed below should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues.

Respectfully Submitted,

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